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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,751	11/20/2001	Manabu Nishizawa	100809-00092 (SCEY 19.188	9662
26304	7590	02/11/2004	EXAMINER	

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ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 02/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/989,751

Applicant(s)

NISHIZAWA ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

***Claim Rejections - 35 USC § 101***

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The analysis of whether an invention is non-statutory is a two-prong test. First, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Second, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *See, State Street Bank and Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. *See In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed Cir. 1994).

In this case, claims 1 and 2 are non-statutory because they do describe the application, use or advancement of a technological art. Notably, claim 3, which depends upon claim 1, meets this standard because it includes the feature of an operation means.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory because they describe a computer program which is not stored on a computer-readable medium.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application GB 2,136,303 A to McNeight et al.

McNeight discloses a game in which a player with a telephone receiver remotely controls an object by commands which are automatically converted to control signals. *See abstract*. The commands may be voice commands converted to control signals by a speech recognition arrangement. *See id*. Alternatively, a standard TV game control console may be used, the joystick and push button being connected to a tone generator and the tones being transmitted telephonically to the studio for conversion by a computer into control signals for the TV game. *See id*. The features of the claimed invention that are taught by McNeight are discussed below.

Claims 1, 4, 7 and 10. McNeight discloses the following features of the claims:

- a. Recognizing a voice. *See p. 1:40-49, 1:98-104*.
- b. Determining a parameter correlated to an object. *See id*. In particular, voice commands are recognized and converted into signals which alter parameters correlated to a game object's position, rotation, or action.
- c. Controlling the object based on the altered parameter. *See id*. In particular, the alternated parameter controls the object the change position, rotate or perform and action. For example, the verbal command "shoot" changes a parameter in the game software causing the display of the game object firing at a target.

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As listed above, McNeight teaches every feature of the claims. Consequently, the claims are unpatentable because they are anticipated by McNeight.

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Claims 2, 5 and 8: McNeight discloses moving an object along a predetermined path. *See id.* In particular, the reference describes the use of voice commands to control the well known video game SPACE INVADERS released in 1978 by Bally-Midway. *See p. 1:8-10, 1:98-104.* The game requires the player to control a cannon to slide left and right along a predetermined path. Hence, McNeight anticipated the feature of moving an object along a predetermined path.

Claims 3, 6 and 9: McNeight discloses controlling the object in response to operating through an operating means. *See p. 1:50-67, 1:98-104.*

***Prior Art, Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- a. 'Coin-Op Museum: Space Invaders' (1995), downloaded from <[http://www.klov.com/-game\\_detail.php?letter=S&game\\_id=9662](http://www.klov.com/-game_detail.php?letter=S&game_id=9662)> on Feb. 2, 2004 describes the operation of the game SPACE INVADERS.
- b. U.S. Patent Application Publication 2002/0161586 A1 (Oct. 31, 2003) discloses an analogous system employing voice recognition to control an object.

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c. U.S. Patent 6,538,666 B1 (Mar. 25, 2003) discloses an analogous system employing voice recognition to control an object.


d. U.S. Patent 6,077,164 (Jun. 20, 2000) discloses an analogous system employing voice recognition to control an object.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

  
S. THOMAS HUGHES  
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